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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Oskar Pacher

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EXAMINER

YANG, JIE

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1793

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,719	Applicant(s) PACHER ET AL.	
	Examiner JIE YANG	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim 1-3 have been amended, claim 11 is added as new claim, and claims 1-11 remain for examination.

Status of the Precious Rejection

The previous rejection of claim 1 under 35 U.S.C. 112 second paragraph for indefinite is withdrawn in view of the applicant's amendment filed on 4/17/2009.

However, a new ground(s) of rejection under 35 U.S.C. 112 first paragraph is made as following.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case, the feature of 0.1 to less than 0.5wt% Mo and greater than 0.15 to 0.25wt% V in the instant claim 1 is not disclosed by the original specification. The Examiner notes the proposed upper limit of 0.5wt% Mo and low limit

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of greater 0.15wt% V are not in the original specification. Therefore, there is no literal support for this feature. See MPEP 2163.05 III.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okui et al (JP 2001-123248A, thereafter JP'248) in view of Ota et al (EP 1083237A2, thereafter EP'237).

JP'248 in view of EP'237 is applied to the claims 1-4 and 7-9 for the same reason as stated in the previous rejections dated 12/19/2008.

Regarding the amended limitation in the instant claim 1, JP'248 does not specify adding 0.1-0.5wt% Mo and 0.15-0.25wt% V in the alloy. EP'237 teaches a ferritic Cr-containing steel sheet having excellent ductility, formability, and anti-ridging properties (Abstract of EP'237). The comparisons of compositions between EP'237 and the instant invention are listed in the following table. The low limit of 0.5wt%Mo taught by EP'237 is

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very close to the 0.51wt%Mo as recited in the instant claim and the high limit 0.15wt%V is very close to the 0.151wt%V as recited in the instant claim. All the major composition ranges disclosed by EP'237 (Paragraphs [0040]-[0067] of EP'237) overlap or are very close to the composition ranges of the instant invention, which is a prima facie case of obviousness. SEE MPEP 2144.05 I. Because both JP'248 and EP'237 teach the same ferritic Cr-containing steel sheet, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the alloy with the claimed composition of Cr, C, Si, Mn, Ni, Mo, Cu, N, Ti, Nb, V, and Fe from the composition disclosed by EP'237 to manufacture the spring elements of JP'248 because JP'248 and EP'237 disclose the same utility throughout the disclosed ranges.

Element	From instant Claim 1 (in wt%)	EP'237 (in wt%)	Overlapping range (in wt%)
C	0.03-0.12	0.001-0.12	0.03-0.12
Cr	13-20	11-18	13-18
Si	0.2-0.9	0-1.0	0.2-0.9
Mn	0.3-1	0-1	0.3-1
Ni	0-0.5	0-1	0-0.5
Mo	0.1-less than 0.5	0.5-2.5	--
Cu	0.05-1.0	0.5-2.5	0.5-1.0
N	0.02-0.5	0.01-0.12	0.02-0.12
Ti	0-0.01	Optional 0.05-0.5	0
Nb	0.01-1.0	Optional 0.05-0.5	0.01-0.1
V	Greater than 0.15-0.25	0-0.15	--
Fe	Balance	Balance	Balance

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The amendments of claims 2 and 3 do not change the scope of the claims.

Regarding the newly added claim 11, the limitation of spring rail for wipers is an intended use for the ferritic stainless steel of JP'248 in view of EP'237, which does not add patentable weight for the instant invention. MPEP 2111.02 II. Furthermore, the spring elements of JP'248 include spring rail for wipers as recited in the instant claim.

Claims 5-6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'248 in view of EP'237 as applied in claims 1-4, 7-9 and further in view of Baba (JP 60-213246, thereafter JP'246).

JP'248 in view of EP'237 and further in view of JP'246 is applied to the claims 5, 6, and 10 for the same reason as stated in the previous rejections dated 12/19/2008

Response to Arguments

Applicant's arguments filed on 4/17/2009 with respect to claims 1-11 have been fully considered but they are not persuasive.

Applicants' arguments are summarized as follows:

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1, Regarding the changing of the numerical range, the analysis must take into account which range one skilled in the art would consider inherently supported by the discussion in the original disclosure. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

2, It is applicant's contention that the Examiner relied upon hindsight to arrive at the determination of obviousness, for example, "molybdenum" or "vanadium" for incorporation into the ferritic steel composition in JP'248, when the EP'237 relates to steel composition that is characterized by its ductility, formability, and anti-ridging properties, i.e. properties that have nothing in common with elasticity or springiness. The JP'248 and EP'237 references were combined piecemeal without any suggestion or motivation for their combination without regard to the purpose of the applicant's invention.

Examiner's responses are as follows:

Regarding the argument 1, although the applicant discloses Mo from 0.1 to 2wt% and 0.02 to 0.25wt%V in the original application, however, there is no literal support for the proposed upper limit of 0.5wt% Mo and low limit of greater 0.15wt% V. Therefore, the amended ranges 0.1 to less than 0.5wt% of molybdenum and greater than 0.15 to 0.25wt% of vanadium are recognized as new matters. See MPEP 2163.05 III.

Regarding the argument 2, as pointed out in the rejection for the instant claim 1, all the major composition ranges disclosed by JP'248 in view of EP'237 overlap or are very close to the composition ranges of the instant invention, which is a prima facie case of obviousness. SEE MPEP 2144.05 I. The applicant can rebut a prima facie case

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of obviousness based on overlapping ranges by showing the criticality of the claimed range. See MPEP 2144.05 [R-5] III. However, the Examiner notes that the applicant has not provided any persuasive evidence to show the criticality of the claimed ranges of 0.1 to less than 0.5wt% of molybdenum and greater than 0.15 to 0.25wt% of vanadium, For example, the example E5 in tables I and II of the instant specification having 0.85wt% Mo, which is outside the claimed Mo range, but E5 is still good in the properties; and the vanadium is not even an essential element for the alloy samples E1 to E5 of the instant invention because vanadium is not included in the composition list of table I of the instant specification. There is no any data to prove the criticality of the claimed range of 0.15 to 0.25wt% of vanadium. See MPEP 716.02(d) II.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884.

The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/

Supervisory Patent Examiner, Art Unit 1793